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CORNING, NY 14831

EXAMINER

JOISIL, BERTEAU

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PAUL G. DEWA and RICHARD L. WIGGINS

Appeal 2016-000266
Application 13/221,115¹
Technology Center 2400

Before ELENi MANTIS MERCADER, JAMES W. DEJMEK, and
SCOTT E. BAIN, *Administrative Patent Judges*.

BAIN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Non-Final Rejection of claims 1–27, which constitute all claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ Appellants identify Corning, Incorporated as the real party in interest. App. Br. 2.

STATEMENT OF THE CASE

Appellants' invention relates to a micro-electro-mechanical (MEMS) based surveillance system that can record images of an object from different wavelength regions. Abstract. Claim 1 is representative of the invention and the subject matter of the appeal, and reads as follows:

1. A micro-electro-mechanical (MEMS) based surveillance system for imaging an object, the MEMS based surveillance system comprising:

an imaging optic positioned to receive light associated with the object;

a micro-mirror array positioned to receive the light associated with the object from the imaging optic;

one or more wavelength selective beamsplitters positioned to receive at least a portion of the light associated with the object from the micro-mirror array; and

a plurality of photo-detectors comprising a first photo-detector and a second photo-detector each of which is positioned to receive the at least a portion of the light associated with the object that was reflected from or passed through the one or more wavelength selective beamsplitters, wherein the first photo-detector is sensitive for the at least a portion of the light associated with the object that is within a first wavelength band, and wherein the second photo-detector is sensitive for the at least a portion of the light associated with the object that is within a second wavelength band.

App. Br. 21 (Claims App'x).

PRIOR ART

Hafeman et al.	US 6,496,260 B1	Dec. 17, 2002
Krill	US 2004/0021770 A1	Feb. 5, 2004
Fermann et al.	US 2009/0201575 A1	Aug. 13, 2009
Furuya et al.	US 2009/0323172 A1	Dec. 31, 2009
Brady et al.	US 2010/0171866 A1	July 8, 2010

THE REJECTIONS ON APPEAL

Claims 1, 5–7, 11–13, and 16–27 stand rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Brady et al. (“Brady”), Fermann et al. (“Fermann”), Krill, and Hafeman et al. (“Hafeman”). Non-Final Act. 5–18.

Claims 2, 4, 8, 10, and 14 stand rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Brady, Fermann, Krill, Hafeman, and Furuya et al. (“Furuya”). *Id.* at 18–20.²

Claims 3, 9, and 15 stand rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Brady, Fermann, Krill, Hafeman, and Handschy et al. (“Handschy”). *Id.* at 20–21.

ANALYSIS

We have reviewed the Examiner’s rejections in light of the arguments raised in the Briefs. On the record before us, we cannot sustain the Examiner’s rejections.

Appellants argue claims 1, 5–7, 11–13, and 16–27 a group, App. Br. 6, and we choose claim 1 as representative of the group. *See* 37 C.F.R. § 41.37(c)(4). Appellants contend the Examiner erred in finding the cited combination of references teaches several limitations of claim 1, including a “micro-mirror array,” “selective beamsplitters,” and “photo-detectors,” all

² The rejections of claims 2, 3, 4, 8–10, 14, and 15 did not expressly cite Krill and Hafeman, but because the subject claims are dependent, we read the rejections as including the references cited in the rejection of their base claims.

positioned as recited in claim 1. App. Br. 6–18. Appellants further argue that even if all of the claim limitations could be found in the references, the Examiner erred in failing to provide an adequate rationale or motivation for combining the references. App. Br. 10; Reply Br. 3–6. We are persuaded by Appellants’ argument regarding rationale or motivation to combine, and therefore we do not reach the other arguments.

In the Non-Final Office Action on appeal, the Examiner finds that one of ordinary skill would combine Brady, Fermann, Hafeman, and Krill because doing so would create a MEMS based surveillance system “with certain technical and commercial advantages over prior technology.” Non-Final Act. 8. As Appellants argue, App. Br. 10, however, the conclusory statement that one of ordinary skill would recognize unspecified “advantages” is not a sufficient reason for combining the references. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (Examiner must provide “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”). The Examiner does not cite any such advantages that would be known to one of ordinary skill, and to the extent the Examiner was referring to advantages realized by Appellants’ claimed invention (as is implied in the Answer (at 5)), that would be impermissible hindsight. *See id.* at 421.

The Examiner’s Answer similarly does not offer adequate support for combining the references. The Examiner asserts the “conclusion [of obviousness is] reached on the basis of the facts gleaned from the prior art,” but does not identify those facts. Ans. 5. The Examiner further asserts that one of ordinary skill “would know how to use the individual components . . . to achieve similar effects as expressed in claim 1,” *id.*, but we agree with

Appellants' argument that this is a conclusory statement unsupported in the record. We, accordingly, are persuaded on the record before us that the Examiner erred in combining the references. *See KSR*, 550 U.S. at 418.

For the foregoing reasons, we do not sustain the rejection of claims 1, 5–7, 11–13, and 16–27 under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Brady, Fermann, Krill, and Hafeman. For the same reasons, we also do not sustain the rejections of the remaining dependent claims.

DECISION

We REVERSE the Examiner's rejections of claims 1–27.

REVERSED